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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD ALLEN BROWN

Appeal 2008-1911
Application 10/047,817
Technology Center 1600

Decided: June 11, 2008

Before TONI R. SCHEINER, DONALD E. ADAMS and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1, 7-9, 11-32, and 53-58, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to a pigmented cosmetic composition (claims 1, 7-9, 11-28, and 53-58) and a particulate sunscreen composition (claims 29-32). Claim 1 is illustrative:

1. A pigmented cosmetic composition comprising a water-in-oil emulsion, said emulsion comprising:

- (a) from about 30% to about 40% by weight of an oil phase;
- (b) from about 30% to about 50% by weight of an aqueous phase;
- (c) from about 5% to about 15% by weight of a pigment;
- (d) from about 3 to about 6% by weight of a cetyl dimethicone copolyol emulsifier; and
- (e) a separation inhibitor comprising a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, and wherein said silicone elastomer is present in an amount of from about 0.1% to about 7% by weight of said composition, wherein the composition is stable for at least three months at about 50 °C.

The Examiner relies on the following prior art references to show unpatentability:

Stepniewski et al.	US 5,599,533	Feb. 4, 1997
Collin et al.	US 5,656,672	Aug. 12, 1997
Rapaport	US 5,730,991	Mar. 24, 1998
Dorogi et al.	US 5,882,661	Mar. 16, 1999

The rejection as presented by the Examiner is as follows:

Claims 1, 7-9, 11-32, and 53-58 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Stepniewski, Rapaport and Dorogi with or without Collin.

We reverse.

DISCUSSION

The Examiner finds that Stepniewski teaches a cosmetic formulation that comprises an oil phase, an aqueous phase, a pigment, cetyl dimethicone copolyol, and a separation inhibitor in concentration ranges that include the ranges set forth in Appellant's claimed invention (Ans. 4-5). Specifically, the Examiner finds that Stepniewski teaches a formulation comprising 0.01-20% by weight of cetyl dimethicone copolyol (Ans. 7).

The Examiner finds that Collin teaches "water-in-oil compositions which preferably comprise 'a silicone-containing emulsifying agent, which is used in a proportion of from 0.5% to 10%, and preferably from 1% to 6%, of the total weight of the emulsion'" (Ans. 8). In this regard, the Examiner finds that Collin exemplifies "two cosmetic compositions wherein the amount of cetyl dimethicone copolyol is 3% by weight of the composition (Examples 2 and 4)" (*id.*).

To reach limitations of the dependent claims that are not taught by Stepniewski, the Examiner relies on Rapaport and Dorogi. For example, as to the requirement in claim 55 of a sunscreensing agent that is octyl methoxycinnamate, the Examiner relies on Rapaport to teach "that octyl methoxycinnamate is a preferred sunscreen agent for use in topical compositions" (Ans. 5). As to the requirement in claim 57 of a preservative that is at least one compound selected from the group consisting of phenoxyethanol, methylparaben, propylparaben, and disodium ethylenediaminetetraacetate (EDTA), the Examiner relies on Dorogi to "teach that phenoxyethanol, methyl paraben and propyl parabene are preferred preservatives for use in topical compositions" (*id.*).

Appellant's argument focuses on the cetyl dimethicone copolyol component of the claims. Each of Appellant's claims requires from about 3 to about 6% by weight of a cetyl dimethicone copolyol emulsifier. According to Appellant "Rapaport and Dorogi et al. do not even mention the use of cetyl dimethicone copolyol in any amount, let alone in the amount of about 3-6wt%" and "Stepniewski et al. broadly describes the use of a surfactant in the range of about 0.01-20 wt%" (App. Br. 4). Appellant, however, does not dispute that Collin teaches cosmetic compositions comprising cetyl dimethicone copolyol in a concentration of from 0.5% to 10%, and preferably from 1% to 6% and provides two examples of cosmetic compositions comprising 3 wt % cetyl dimethicone copolyol (Ans. 8).

Relying on *In re Aller*, 220 F.2d 454, 459 (CCPA 1955) the Examiner finds that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation" (Ans. 7 and 10). Accordingly, the Examiner concludes that "[b]ecause all of the components of the herein-claimed topical compositions have been disclosed in the prior art for incorporation into topical compositions, the optimization of the amount of the components is not considered inventive because it is a matter of routine experimentation for the skilled artisan possessing the above-cited prior art" (Ans. 7). While we agree with the initial premise set forth by the Examiner, we disagree that the evidence of record leads to a conclusion that Appellant's claimed invention is *prima facie* obvious.

Exceptions to the general rule set forth in *Aller* have been found wherein "the results of optimizing a variable, which was known to be result-effective, were unexpectedly good." *In re Antonie*, 559 F.2d 618, 620

(CCPA 1977). Appellant's claimed invention requires that "the composition is stable for at least three months at about 50 °C" (*see e.g.*, Claim 1). The Examiner recognizes that Stepniewski does "not teach that the compositions comprising the emulsion are stable for at least three months at about 50 °C" (Ans. 5). The Examiner does not identify, and we do not find, a teaching in any of Rapaport, Dorogi, or Collin that makes up for this deficiency in Stepniewski. Instead, we are left with the Examiner's assertion that "[t]he recitation that the instantly claimed compositions are 'stable for at least three months at about 50 °C' is an inherent feature of the product rendered obvious by the teachings of the prior art" (Ans. 6). We are not persuaded as Appellant's declaratory evidence refutes the Examiner's conjecture.

Specifically, Appellant provides declaratory evidence that "compositions comprising a cetyl dimethicone copolyol emulsifier in an amount *outside* of the claimed range were *not* similarly stable" (App. Br. 5). According to Appellant, the fourth Rule 132 Declaration "summarizes the results of the three prior Rule 132 Declarations and describes the amounts of all the ingredients in each formulation" (*id.*). In the fourth Declaration, Appellant provides "[c]omparative Samples A and B comprising about 1 wt% and about 8 wt% cetyl dimethicone copolyol, respectively, were not similarly stable" to compositions comprising cetyl dimethicone copolyol in the range set forth in the claimed invention. Stated differently, Appellant has provided evidence that a cetyl dimethicone copolyol concentration that falls on either side of the claimed concentration range produces a result that fails to meet the requirements of the claimed invention.

While the Examiner acknowledges the results of Appellant's fourth declaration the Examiner simply restates that *Aller* supports a finding that

“[it] is a matter of routine experimentation to test various concentrations of the emulsifier from within the range taught by Stepniewski et al. to arrive at the optimal range from within the broad disclosure” (Ans. 10). The Examiner, however, fails to appreciate that none of the prior art references relied upon teach a composition that is stable for at least three months at about 50 °C and therefore, there is no way a person of ordinary skill in the art would have been directed to optimize the concentration of cetyl dimethicone copolyol to reach this specific stability requirement.

At best, Collin teaches a preparation that is stable for two months at 45 °C (Collin, col. 7, ll. 17-44). However, as Appellant explains, while Collin may exemplify compositions comprising 1, 2, and 3 wt% cetyl dimethicone copolyol, “[i]t cannot be said that Collin et al. knowingly provides one of [ordinary] skill in the art the knowledge to prepare a composition that is stable for at least three months at about 50 °C by adding 3-6 wt% of a cetyl dimethicone copolyol” (App. Br. 7). The Examiner fails to rebut this argument. Accordingly, we find that the weight of the evidence falls in favor of Appellant.

Accordingly, we reverse the rejection of claims 1, 7-9, 11-32, and 53-58 under 35 U.S.C. § 103(a) as unpatentable over the combination of Stepniewski, Rapaport and Dorogi with or without Collin.

CONCLUSION

In summary, we reverse the rejections of claims 1, 7-9, 11-32, and 53-58 under 35 U.S.C. § 103(a) as unpatentable over the combination of Stepniewski, Rapaport and Dorogi with or without Collin.

Appeal 2008-1911
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REVERSED

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